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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|------------------|
| 10/773,428   | 02/09/2004  | Al Said M. Mohammed  | 21090.00                        | 6588             |
| 37833  | 7590        | 06/27/2006           |                                 |                  |
| LITMAN LAW OFFICES, LTD<br>PO BOX 15035<br>CRYSTAL CITY STATION<br>ARLINGTON, VA 22215 |             |                      |                                 |                  |
|  |             |                      | EXAMINER<br>WARTALOWICZ, PAUL A |                  |
|  |             |                      | ART UNIT<br>1754                | PAPER NUMBER     |

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/773,428

Applicant(s)

MOHAMMED, AL SAID M.

Examiner

Paul A. Wartalowicz

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed on April 17, 2006 have been fully considered but they are not persuasive.

Applicant argues that nowhere in Bonnett does it indicate that the tablecloth T is to be "closed" over the tabletop and that it is clear that if the tablecloth were closed over the tabletop, the device would no longer operate in the manner intended.

This argument is not persuasive for the following reason: In response to applicant's argument that if the tablecloth of Bonnett were closed over the tabletop, the device would no longer operate in the manner intended, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, Bonnett is adequately structured to perform the intended use of being closed over a tabletop.

Applicant argues that If Bonnett tablecloth were to include such an elastic band, the tablecloth would either not lay flat on the tabletop as the device is intended to be used, or in the modification the peripheral edges would be drawn over the edges of or beneath the tabletop and would not be in place to prevent liquid run-off.

This argument is not persuasive for the following reason: the combination of Bilotti and Bonnett teaches that Bonnett tablecloth includes an elastic band in order to provide a tight fit over the tabletop. The peripheral edges 2 would still be in place to prevent liquid run-off and the elastic band would be in place at the edge of the tabletop in order to provide a tight fit over the tabletop.

In response to applicant's argument that a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case the proposed modification does not render the prior art invention being modified unsatisfactory for its intended purpose.

In response to applicant's argument that if the Bonnett tablecloth were to include such an elastic band, the tablecloth would either not lay flat on the tabletop as the Bonnett device is intended to be used, or the peripheral edges would be drawn over the edges of the tabletop, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues that if the handles replace the cinch piece 3 or if the handles were fixedly attached to the peripheral edge of Bonnett in addition to cinch piece 3, it would not be obvious to make such a modification.

This argument is not persuasive for the following reason: The purpose of introducing the handles of Carter stems from providing ease of transporting the contents of the tabletop. This can be achieved by providing the handles in such a way as to ease the elastic from the bottom of the tabletop to therefore provide ease of transporting elements.

In response to applicant's argument that if the cinch piece 3 were replaced with the handles of Carter, the combination would be nonobvious, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnett ('554) in view of Bilotti ('748) and Carter ('758) and Petriekis et al. ('636).

Bonnet teaches a circular tablecloth (fig 3, #7) convertible to a garbage bag (col. 1, lines 6,12), comprising a flexible panel (col. 1, line 8) closing over a table top (fig 1, #2) and at least two handles attached to said flexible panel proximate said edge (fig 3, #3) whereby tablecloth converts into a garbage bag (fig 6) by pulling on the draw string cinch system (fig 3, #3), said garbage bag being carried by said handles to a place for disposal.

Bonnet fails to teach an expandable peripheral edge comprising an elastic band attached to and surrounding said peripheral edge.

Bilotti, however, teaches a circular table cover (fig 3, #10) comprising an expandable peripheral edge further comprising an elastic band (fig 3, #14) that stretches when placed over a table top and contracts to it's original shape when in abutment with the table top and providing a tight fit of the table cover over the table top (meets the intended use limitation of being expandable from a retracted position, col. 1, lines 25-31).

Thus, it would have been obvious to one of ordinary skill in the art to have an elastic strip on the peripheral edge of the tablecloth as both provide a means to cover the table and convert to a garbage bag.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided an elastic band in the table cover of Bonnett in order to provide a tight fit over the table top as taught by Bilotti.

Bonnett teaches a tablecloth disposal system as described above. Bonnett fails to teach a flexible panel comprising a two-ply polymeric sheet further comprising polyvinyl or polyester.

Petrikis et al. however, teaches a two-ply bag (container, col. 5, lines 54-57) that comprises a polymeric material that has sufficient flexibility (col. 5, line 43) such as polyester or polyvinyl chloride (col. 5, line 52) for the purpose of having a flexible bag.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided a two-ply bag comprising polyester or polyvinyl chloride in Bonnett and Bilotti in order to have the flexible bag as taught by Petrikis et al. since these materials are well known in the art for flexibility.

Bonnett also fails to teach as to the limitations wherein each of said at least two spaced handles comprising a polymeric strip having a pair of attachment end portions and a central grasping portion, each attachment end portion of each said handle being heat welded to said expandable peripheral edge, thereby fixedly attaching said at least two handles to said expandable peripheral edge.

Carter, however, teaches a flexible, collapsible bag (col. 1, lines 62-64) wherein nylon handles (inherently teach attachment end portions and a central grasping portion,

col. 1, lines 62-66) are attached for the purpose of providing ease of transporting the contents (col. 1, lines 28-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to provide handles in Bonnett that are attached to the peripheral edge of the bag in order to provide ease of transporting the contents (col. 1, lines 28-31) as taught by Carter.

In claim 1, it appears that the instantly claimed product by process is the same as that which is claimed (handles comprising a polymeric strip having a pair of attachment end portions and a central grasping portion, each attachment end portion of each said handle being heat welded to said expandable peripheral edge, thereby fixedly attaching said at least two handles to said expandable peripheral edge). When the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct and not the examiner to show the same process as making. *In re Brown*, 173 USPQ 685 and *In re Fessman*, 180 USPQ 324.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Wartalowicz whose telephone number is (571) 272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul Wartalowicz  
June 8, 2006



COLLEEN P. COOKE  
PRIMARY EXAMINER